

Amendment Under 37 CFR §1.116
EXPEDITED PROCEDURE
Art Unit 2176

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Reinhard Heinrich Hohensee

Serial No.: 09/461,521

Filed: December 14, 1999

For: **METHOD AND SYSTEM FOR
MULTIFORMAT PRESENTATION**

§ Attorney Docket No. BO9-99-013
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§ Examiner: Charles A. Bieneman
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§ Art Unit: 2176
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RESPONSE C UNDER 37 CFR § 1.111

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Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

OFFICIAL

Sir:

This Response is submitted in reply to the Final Office Action dated January 29, 2004, having a shortened statutory period set to expire April 29, 2004. It is believed that no fee is required by this amendment; however, in the event any additional fees are required, please charge any such fee to **IBM Corporation Deposit Account Number 50-0563**.



INTRODUCTORY COMMENTS

This Response is submitted in reply to the Final Office Action dated January 29, 2004, having a shortened statutory period set to expire April 29, 2004. Claims 1-2, 4-7, 9-12 and 14-15 are pending. No amendments to the Claims have been made.

CLAIM REJECTIONS – 35 U.S.C. § 103

A. The Step of "Comparing" is Not Shown or Suggested

With respect to exemplary claim 1, therein is recited the step of:

for each unit, comparing an amount of data processing required to convert said unit to device-dependent format to a predetermined level of data processing;

Neither *Orton*, *Vanderwiele*, *Alam*, nor *Hohensee* show or suggest this element of exemplary claim 1. While it is argued on page 4 of the present Office Action that performing such a comparison results in advantages when the units are subsequently stored in accordance with the comparison (the step of "comparing"), Applicant's submit that nothing within the prior art suggests making such a comparison. It is argued on page 8 of the Final Office Action that this step is suggested by *Vanderwiele* at col. 5, line 19 - col. 6, line 12. However, it is quite clear from the description in *Vanderwiele* and the flowchart as shown in Fig. 3 that there is no comparison or calculation performed based on "an amount of data processing required to convert" to the various formats. As explained in cols. 5 and 6 and as seen at steps 304, 306, 310, 320, 308 and 330, the only comparison or determination made in the flow of the methodology described in Fig. 3 is of the device and image type. Therefore, the conversion from device independent bits to device dependent bits is performed in every case presented to the methodology (see end blocks 314, 328 and 338). Therefore, *Vanderwiele* is not making any comparison in "amount of data processing" and therefore cannot be showing or suggesting the present invention. There is no storing or output of images or units in DIB (device independent bits), and therefore *Vanderwiele* cannot be showing or suggesting the step of "storing said units, requiring less than predetermined level of data processing to convert to device-dependent format, in device-independent format," as is recited in exemplary Claim 1. Given the failure of the prior

art to show or suggest this element of exemplary claim 1, Applicants respectfully submit that the present invention as claimed in exemplary claim 1, and further similarly as claimed in the remaining pending claims, is patentable over the prior art, and the rejection under Section 103 should be withdrawn.

B. The Prior Art Fails to Show or Suggest "Storing"

Exemplary claim 1 further recites the steps of:

storing said units, requiring less than said predetermined level of data processing to convert to device-dependent format, in device-independent format;
storing said units, requiring more than said predetermined level of data processing to convert to device-dependent format, in device-dependent format based on the classified plurality of presentation devices;

Applicant's submit that nothing within the prior art suggests storing the units based on whether the level of processing required to convert to a device-dependent format exceeds a threshold as determined by the comparison. On page 5 of the present Final Office Action, it is argued that storing "units" in device-independent or device-dependent format, depending upon a comparison of the amount of data processing required to convert the unit to a device-dependent format, would have been obvious to one of ordinary skill in the art at the time of the invention. This bold conclusory statement is repeated in response to Applicant's arguments presented in the previous response on pages 9 and 10 of the Final Office Action. In particular, the Examiner relies on the quote from *Vanderwiele* in the abstract specifying that their system "determines whether [an] images targeted for multiple hardware formats or single hardware format and then provides a conversion from device-independent bits to device-dependent bit formats in the case of the multiple hardware format targeting, or performing image conversion appropriate for the single device in the case of the single device targeting." However, this teaching merely suggests that the type of conversion from device-independent to device-dependent is a function of the target devices for the image, but in no way suggests that a decision on whether to make a conversion from device-independent to device-dependent format is not contemplated by *Vanderwiele*. [insert sentence from above] Consequently, it is not possible for *Vanderwiele* to suggest the above step in exemplary Claim 1 because *Vanderwiele* nowhere even contemplates an algorithm for avoiding the device-independent to device-dependent format conversion, let alone conditioning such a conversion on the "amount of data processing required to convert said

unit to device-dependent format" as the deciding factor in making such a conversion. The *Orton* and *Vanderwiele* references cited storing units in dependent and independent formats, respectively, without considering whether storing in such a format is proper in light of the speed of delivering data or the level of processing required. While the Examiner appears to recognize that the prior art does not show or suggest making such a comparison before determining the type of format to be used in storing the data, the Examiner nonetheless argues in the present Office Action that such a method would be obvious based on the benefits presented by the present invention. Applicants respectfully submit that such an analysis concludes that the present invention is obvious in hindsight of the present invention.

Last, the Examiner has failed to present a *prima facie* case of obviousness for the pending claims. Since the references do not suggest "storing" in conformance with the claims, the Examiner has argued that someone of ordinary skill would find the advantages of the present invention as obvious, and then working backward by arguing that, since the invention is useful, it must have been obvious. Defining the motivation or suggestion to modify the prior to arrive at the present invention in terms of its advantages reveals improper hindsight in the selection of the prior art relevant to obviousness. "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial & Trading Co., Ltd.*, 139 F.3d 977, 45 USPQ2d 1977 (Fed. Cir. 1998). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)).

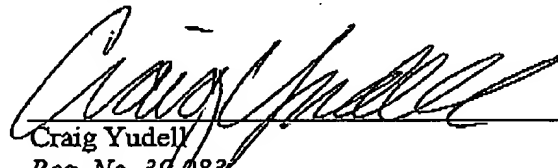
The Examiner presents as "evidence" a bare assertion that the logical process of determining whether to store units in dependent or independent formats is obvious without citing a single reference that performs or suggests making such a comparison before storing units. "However, the test of whether it would have been obvious to select specific teachings and combine them as did the Applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." *In re Dance*, 160 F.3d 1339, 48 USPQ2d 1635 (Fed. Cir. 1998). The Examiner's evidence of obviousness is created from broad

conclusory statements about the knowledge of those of ordinary skill in the art without any objective evidence of a suggestion for making the comparison and then storing the units accordingly, as performed in exemplary claim 1 in the present application. Again, Applicants respectfully submit that such a rejection is improper. "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ADT Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998). *Crown Operations International, Ltd. V. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

In summary, Applicants submit that the prior art of record does not show or suggest comparing the processing power required to convert a unit of an object within a document to a device dependent format in order to determine whether it should be stored in device-dependent or device-independent format is not shown or suggested in the prior art and that the rejection under Section 103 should be withdrawn. Further, Applicants respectfully submit that there is no motivation or suggestion in the prior art to make the combination of steps, means, and instructions as recited in independent claims 1, 6, and 11 and that the Examiner has derived such suggestion in hindsight of the present invention.

For the reasons given above, Applicants respectfully request reconsideration of the claims and submit that the application is now in condition for allowance.

Respectfully submitted,



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